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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/041,772 | 01/08/2002 | Johannes Thoma | 12782-002001 | 3169 |
| 26161 | 7590 | 08/10/2005 | EXAMINER | |
| FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | CALLAHAN, PAUL E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2137 | |
| DATE MAILED: 08/10/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,772

Applicant(s)

THOMA

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

Paper No(s)/Mail Date PC

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-36 are pending in this application and have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 6, 10, 12-17, 20, 22, 26-31, 33, 35, and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schneier, Applied Cryptography 2nd Edition, John Wiley and Sons, 10/1995, pp. 31-34, 47-54, and 566-571.

As for claims 1, 2, 6, 30, 35, and 36, Schneier teaches a method of downloading encrypted e-content to a terminal device comprising: receiving a request for encrypted content from a terminal device; generating a symmetric key and encrypting the e-content with the symmetric key; sending a request to a key server to look up the terminal device public key in a key repository; receiving from the key server the symmetric key encrypted with the public key of the terminal device; (pp. 31-34, Sec. 2.5 Communications using Public Key Cryptography, pp. 47-49 Sec. 3.1 Key Exchange), generating a unique license ID and producing a new entry

in a license repository; and sending a response to the terminal device including the content encrypted with the symmetric key (pp. 31-34, Sec. 2.5 Communications using Public Key Cryptography, pp. 47-49 Sec. 3.1 Key Exchange, pp 56-57 MAC's)

As for claims 12-16, 28, and 29, Schneier teaches a method of activating e-content license with terminal device comprising: sending to a content server a transfer ticket and challenge; receiving a solved challenge and transfer ticket back from the content server; and checking the challenge and transfer ticket to activate the e-content license and storing the e-content license in protected memory. (pp. 31-34, Sec. 2.5 Communications using Public Key Cryptography, pp. 47-49 Sec. 3.1 Key Exchange)

As for claims 10, 17, and 20, Schneier teaches sending from the content server to the key server a free form data to be encrypted with the terminal device's private key, to control further properties of content usage; and receiving by the content server from the key server the encrypted data structure, and a solved random challenge received from the content server ensuring that the terminal device actually communicated with the content server. (p. 58 Needham-Schroeder).

As for claims 22, 26, 27, 31, and 33 Schneier teaches unregistering e-content license at a giver's device; issuing a relinquishing ticket by the giver's device; and registering the license with a borrower's device using the issued relinquishing ticket, in pp. 569-571 Kerberos.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5, 7-9, 11, 18, 19, 21, 23-25, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Colosso, US Patent 6,169,976 B1, Jan. 2, 2001, Snyder et al, US Patent 6,070,171, May 30, 2000.

As for claims 3-5, Schneier teaches all of the limitations of claim 1, upon which claims 3-5 are dependent, but does not teach the additional limitations found in claims 3-5 of the request received by the content server or key server comprising a unique request ID, unique content ID and unique device ID. However Colosso does teach these features in the abstract, fig 2A, fig 2D (customer serial number, connection identifier). Official Notice may be taken of the use of a unique device identifier in such a request as a step which is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features of Colosso and of which Official Notice has been taken into the system of Schneier. It would have been desirable to do so as this would allow for greater security in data transmission.

As for claims 7-9, Schneier teaches all of the limitations of claim 1 upon which claims 7-9 are dependent. However Schneier does not teach the steps of: generating a unique license ID and producing a new entry in the license repository and storing the license ID and symmetric key in the license repository, receiving a request to register the license with the content server upon receipt of the response to the terminal device from the content server, and assigning an owner after the license is registered. However Colosso does teach these steps in the abstract, figs 2C-2F, col. 2 lines 33-67, col. 3 lines 1-67.

As for claim 11, Schneier teaches all of the limitations of claim 10 upon which claim 11 is dependent. However Schneier does not teach the steps of a data structure that controls usage characteristics such as expiration date and maximal view count. Snyder does teach this step in the abstract, fig. 1, fig. 2, col. 2 lines 21-67, and col. 3 lines 1-8. therefore it would have obvious to one of ordinary skill in the art at the time of the invention to have incorporated these features of Snyder into the system of Schneier. It would have been desirable to do so as this would increase the security of the data transmission.

As for claims 18, 19, 21, 23, 24, 32, 34, Schneier does not teach checking, upon receipt of the transfer ticket and the challenge by content server, if the counter value of the transfer ticket matches the expected value of the counter and if the ticket has been previously been used; and incrementing the expected value after checking the counter value, and wherein the transfer ticket further comprises: a unique counter value, a license id, and device id and

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wherein the transfer ticket is encrypted with a private key of the terminal device, however Colosso teaches the characteristics of a transfer ticket of a license i.d. and a device i.d. in the abstract, figs 2C-2F, col. 2 lines 33-67, col. 3 lines 1-67, and Snyder teaches the remaining limitations in fig. 1, fig. 2, col. 2 lines 21-67, and col. 3 lines 1-8. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the features of Snyder and Colosso into the system of Schneier, It would have been desirable to do so as this would increase the security of the data transmission system.

As for claim 25, Schneier does not teach producing a copy of the e-content for a giver to transfer to a borrower. However Snyder does teach this step in co. 3 lines 1-67. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Snyder into the system of Schneier and Colosso. It would have been desirable to do so as this would allow for greater portability of digital content and hence greater utility for the instant invention.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US patent document teaches features pertinent to the Applicant's invention:

Ugon 4,807,288

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Davis 5,473,692

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869.

The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306.

8-3-05

